

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

CUSTOMER NO. 22927

Applicants: Walker *et al.*
Application No.: 09/540,035
Filed: March 31, 2000
Title: RETAIL SYSTEM FOR SELLING PRODUCTS BASED ON A FLEXIBLE PRODUCT DESCRIPTION

Attorney Docket No.: 99-063

Group Art Unit: 3628
Examiner: Frantzy Poinvil

**PRE-APPEAL BRIEF REQUEST FOR REVIEW
of the rejections in the Non-final Office Action mailed August 25, 2006**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Examiner:

Applicants respectfully request Pre-Appeal Brief Review of the rejections set forth in the Non-final Office Action mailed August 25, 2006 as Part of Paper No./Mail Date 20060812 (hereinafter the “Office Action”). All claims being appealed have been at least twice rejected. No amendments are being filed with this request and this request is being filed with a Notice of Appeal. Review is requested for the reasons set forth in the remarks beginning on the following page.

REMARKS

I. Introduction

Claims **5-6, 29, 31-34, 36-41**, and **43-63** are currently pending in the present application. Claims **5, 29, 31-34, 36-41, 43-49, 51**, and **55-56** are independent.

- Claims **5-6, 29, 34**, and **41** are allowed.
- Claims **51-63** have been withdrawn via Election by Original Presentation pursuant to a Restriction Requirement imposed by the Examiner in the Office Action.
- Claims **31-33, 36-40**, and **43-50** stand rejected. In particular:
 - (A) claims **49-50** stand rejected under 35 U.S.C. §102(e) for allegedly being anticipated by U.S. Patent No. 5,732,398 (hereinafter “Tagawa”); and
 - (B) claims **31-33, 36-40**, and **43-48** stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Tagawa.

II. Claim Limitation Disregarded

Claim **39** recites the limitation “*wherein the customer is not guaranteed what specific product will be purchased before the agreement is received.*”

The Examiner appears to agree that Tagawa fails to teach or suggest this limitation where the Examiner states “Tagawa teaches a receiving step to receive from the customer an agreement to purchase a product conforming to the product description for the sale price...**but not prior to revealing the identity** of a specific product to the customer.” Office Action, pg. 5, last paragraph; emphasis added.

The Examiner goes on to state, however, that the above-quoted limitation of claim **39** “does not require a specific step or structure and thus does not attribute any patentable differences apart from Tagawa”. Office Action, pg. 6, lines 4-6.

Applicants respectfully note that there is no rule or authority cited by the Examiner in support of this contention, much less any rule or authority known to Applicants that allows no patentable weight to be *per se* attributed to a limitation such as the above-quoted limitation from claim **39**. In particular, there is no rule or authority that allows “wherein” clauses to *per se* be read out of pending claims.

MPEP § 2111.04 describes the use of “adapted to”, “adapted for”, “wherein”, and “whereby” clauses as *potentially* raising a question regarding the limiting effect of such claimed clauses. MPEP § 2111.04 further points out, however, that “[i]n *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a ““whereby” clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention.” MPEP § 2111.04; emphasis added.

In this case, the Examiner has not presented any argument describing why the recited “wherein” clause is believed to be immaterial to patentability, much less supported such an argument with any evidence on the record. The only statement the Examiner offers is that “there appears [sic] to be no clear or significant advantages” to the claimed limitation. Office Action, pg. 6, line 6. It is unclear how potential advantages of the limitation have any bearing on whether the limitation should be accorded patentable weight.

Applicants believe that the above-quoted limitation is both advantageous and material to claim 39 and, without any argument or evidence to the contrary, should therefore be accorded patentable weight. Applicants also agree with the Examiner’s finding that **Tagawa fails to teach or suggest the claimed limitation.**

At least for this reason, the outstanding § 103(a) rejection of claim 39 cannot properly stand. Applicants therefore respectfully request that the § 103(a) rejection of claim 39 be withdrawn.

III. Obviousness

The Examiner admits (Office Action, pgs. 4-5) that **Tagawa fails to teach the claimed limitations being conducted in the recited order.** The Examiner goes on to state, however, that the order of the process steps recited in the claims is obvious. *Id.* The Examiner offers no reasoning to support this contention of obviousness, however, and indeed appears to be unable to formulate a reason, even with benefit of hindsight, as to why the different order of the steps in the pending claims would be obvious.

In fact, with respect to changing the order of the steps in Tagawa to allegedly teach the pending claims, the Examiner states “there appears to be no clear or significant

advantages of doing so". Office Action, pg. 5, line 13. In other words, while the Examiner alleges that changing the order of steps in Tagawa would be obvious, the Examiner cannot articulate any reason why it would have been obvious, and instead simply relies on the assertion that **changing the order of the steps would have been easy to do.** *Id.*, at pg. 5, lines 9-10 and 14.

At least for this reason, the outstanding § 103(a) rejections of the pending claims cannot properly stand. The Examiner has failed, for example, to establish a *prima facie* case of obviousness at least because the Examiner has simply and utterly failed to articulate any reasoning with respect to the alleged obviousness of the pending claims. Applicants therefore respectfully request that the § 103(a) rejections of the pending claims be withdrawn.

IV. Inconsistent Interpretation of the Term "Product"

In **one portion** of the Office Action, the Examiner interprets a "product", as allegedly described by Tagawa, as comprising an **individual and particular airline seat** (e.g., seat 23A). The Examiner utilizes this interpretation to allegedly show how claim limitations that describe *concealing product identity from a customer until after the time of purchase* are rendered obvious.

In **another portion** of the Office Action, the Examiner interprets the "product", as allegedly described by Tagawa, as comprising an **airline ticket** (e.g., a flight from point A to point B). The Examiner utilizes this interpretation to allegedly show how claim limitations that describe **two different product descriptions for the same product**, and, based on these descriptions, **two different prices for the same product**, are anticipated.

Applicants submit that the varying interpretations of the term "product" as utilized by the Examiner are mutually conflicting and fail to coincide with any interpretation that a reasonable person would attribute to the term. Applicants submit that the term "product", when applied to an airline flight as described in Tagawa, should more appropriately be generally defined as *an airline ticket of a particular class, for a particular flight*. Different tickets for different flights would be different "products", as would different classes of seats on the same flight, while different seats within any

particular class would be different “units” of the same product – much like different units of a particular type of stereo sent from a manufacturing facility are the same “product”, just different units of that product (*e.g.*, differing not in features, but only in serial number).

At least for this reason, the outstanding § 102(e) and § 103(a) rejections of the pending claims, so much as they rely upon these conflicting and unreasonable interpretations of the term “product”, cannot properly stand. Applicants therefore respectfully request that all rejections be withdrawn.

V. Conclusion

At least for the foregoing reasons, it is submitted that all claims are clearly in condition for allowance and Pre-Appeal Brief Review is requested to avoid the unnecessary expense of preparing an Appeal Brief in relation to the current rejections.

VI. Petition for Extension of Time to Respond

Applicants hereby petition for a **one-month extension** of time and authorize the charge of **\$120.00** to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If any other and/or additional extension of time is required, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

Respectfully submitted,

December 20, 2006

Date

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